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Richard M. Saccocio
Richard M. Saccocio, P.A.
100 Southeast 12th Street
Ft. Lauderdale, FL 33316

EXAMINER

MYHRE, JAMES W

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3622

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GROUP 3800

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/910,654
Filing Date: July 20, 2001
Appellant(s): BURROWS, RODGER

Richard M. Saccocio
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 20, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the Appellant indicates that claims 1, 5, 15, 17, and 18 should not stand or fall together "because of different limitations in each group" (page 5), but only presented arguments in reference to Claim 1. The Examiner further notes that, as the Appellant pointed out, Claims 1 and 5 are method claims and Claims 15, 17, and 18 are corresponding apparatus claims which perform the steps of the

methods claims. While the apparatus claims include such terminology as "airline ticket reservation apparatus" and "data storage apparatus", there is no indication that these are anything more than a standard general purpose computer system with a processor and a memory storing computer programs to cause the computer to perform the steps outlined by the method claims. Therefore, these claims should stand or fall together. The Examiner believes that the grouping of the claims should follow the groupings used in the final rejection and as argued by the Appellant in the Brief.

Group I: Claims 1, 5, 15, 17, and 18;

Group II: Claims 2-4;

Group III: Claims 6-9; and

Group IV: Claims 10-14.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,521,966

FRIEDES et al

5-1996

Industry Agent's handbook (IAH), Section 70.0 (2000 Ed.)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 1-15, 17, and 18 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

As shown in the prior art submitted by the Applicant along with the Petition to Make Special, the Airlines Reporting Corporation (ARC) held meetings starting in 1999

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to discuss removing the requirement for travel agents to store copies of agent coupons in either physical copies or on microfiche. During the September 29, 1999 Travel Distribution Task Force (TDTF) at the ARC Headquarters, it was disclosed that the ARC was "looking at the possibility of eliminating the requirement for agent retention of paper agent coupons" (page 3), that the "ultimate goal is to have a master storage database for these documents", and that "ARC would soon be allowing accredited entities to store these agent coupons on optical disc rather than paper" (page 4). During an October 27, 1999 press release, it was noted that the ARC management presented the Joint Advisory Board-Agent Reporting Agreement (JAB-ARA) "with draft text approving various media for electronic and optical storage of agent sales reports and supporting documents". This was further reported in the November 1, 1999 issue of Travel Weekly, a travel industry publication, as a plan which "would eliminate one more piece of paper - the agent's coupon" and that "Another option that the ARC is considering is to allow agents to keep their own electronic records to satisfy the two-year requirement to store agent's coupons". These plans evolved into an revised Industry Agent's Handbook, Section 70.0, which stated that "an Agent may, upon prior written notice to, and written approval by ARC, maintain the required documents on microfiche or on an optical storage medium as specified below"..."must be copied to microfiche/film or to a non-magnetic optical medium that uses a "write-once, read-many" technology which will prevent overwriting the stored data (e.g. WORM technology). Certain non-volatile storage medium, such as CD-ROMs, optical disks, DVDs, and laserdiscs, may be determined to be acceptable storage media". Finally, in the November 2, 2000 meeting

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of the Agent Working Group it was noted that "In June 2000, ARC made an announcement that IAR agents can now print agent coupon on non-accountable stock or capture the coupon data on an optical media (i.e. CD-ROM, DVD, etc.)"(emphasis added) and the "Agents now have the option to pursue the own agent coupon storage solutions."

The present application and all of the claims are directed towards this new policy of the ARC, a policy which had been discussed at length in ARC and other travel industry meetings and publications for over a year before the priority date claimed by the Applicant. The Examiner also notes that the Applicant is not listed as an attendee in any of the meetings cited above. Thus, it appears that the Applicant has taken the advice of the ARC board and developed a computer program to electronically store the agent's coupons. However, merely writing a program to implement another person's (or entity's) idea or a new law/requirement is not an inventive step.

(b) Claims 1-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedes et al (5,521,966) in view of Industry Agents' Handbook (IAH), Section 70.0 (2000 Ed.).

Claims 1, 5, and 15, 17, and 18: Friedes discloses a method and apparatus for generating airline tickets, comprising:

- a. Generating agent coupon data simultaneously with the printing of an airline ticket by a reservation apparatus;
- b. Transmitting the agent coupon data electronically to a storage apparatus;

- c. Providing each agent coupon data with an identifier;
- d. Storing the agent coupon data;
- e. Retrieving and printing the stored agent coupon data.

Friedes discloses conducting an electronic sale of an airline ticket, printing the airline ticket, and sending the transaction information to the host database (col 5, lines 34-38 and col 6, line 66 - col 7, line 5). It is required within the travel industry for an agent to complete and store uniquely identified agent coupon data for each transaction completed or voided. At the time of the filing of the Friedes reference, agents were required to print out a copy of the agent coupon and store it for two either as a paper copy or as a microfiche copy. However, starting in June 2000, the Airlines Reporting Corporation authorized electronic storage of the agent's coupons (IAH, paragraphs 2 and 2(1)). IAH also discloses that the electronically stored documents "must be accessible by an ARC representative" and that a PC and printer "must be available to an ARC representative or carrier representative at the site where the microfiche/film or optical copies are stored and maintained" (paragraphs 2(2) & 2(3)). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain the agent coupon data in Friedes as an electronic file, available for retrieval and printing. One would have been motivated to store the agent coupon electronically in view of the newly revised section of the IAH delineating the requirements for such storage means.

Claims 2-4: Friedes and IAH disclose a method for printing an airline ticket as in Claim 1 above. While Friedes does not explicitly disclose the storage medium on which

the gateway database and the host database reside, IAH discloses numerous storage media, such as CD-ROMs, optical disks, DVDs, laserdiscs, hard drives, zip drives, floppy disks, magnetic tapes, and other magnetic media. Although IAH does not accept storage of the agent coupon data on hard drives, its disclosure teaches the possibility of storing the data on such media and renders it obvious to one having ordinary skill in the art at the time the invention was made that the data could be stored on any of the disclosed media. Batch processing, for either storage, transmission, or retrieval, is very well known within the database arts and would have been an obvious method of transmitting/storing/retrieving data, especially when a large amount of transactions need to be handled.

Claims 6-9: Friedes and IAH disclose a method for printing an airline ticket as in Claim 5 above, and Friedes further discloses connecting the reservation apparatus with the storage apparatus over switched networks and local area networks (LANs)(col 3, lines 55-60 and col 5, lines 1-9). While neither reference explicitly discloses that the connection is serial, via modem, via an intranet or the Internet, these are all common types of networks and network connection and would have been obvious choices to one having ordinary skill in the art at the time the invention was made. One would have been motivated to choose one or more of these connections in order to limit or expand the range of agents who can access the system, depending on the desires of the system designer.

Claims 10-14: Friedes and IAH disclose a method for printing airline tickets as in Claim 1 above. IAH further discloses that the identifier data includes many types of

information, such as the "agency code number, sales period ending date, ticket number and stock number" (paragraph 2(5)). Friedes also discloses that the transaction information may include such information as the passenger's "name, address and credit card numbers" along with other selected information such as "frequent flyer number, seat preference, or special meal requirements" (col 6, lines 60-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any or all of this information as part of the transaction data being stored in Friedes. One would have been motivated to include these types of data in order to provide a more complete record of the transaction as required by ARC and by other "governmental or tax authorities" (IAH, See Note).

(11) Response to Argument

a. The Examiner's Rejection of Claims 1-15, and 17, 18 Under U.S.C. 102(f)

The Appellant argues that since ARC did not authorize storing the agent coupon as data, only as an image, ARC could not anticipate the invention (page 10); and that the ARC only authorized the storage of agent coupon *images* and not merely the agent coupon *data* onto optical media, such as laser discs, CDS, etc. The Appellant further argues that storing the data of the agent coupon instead of an image of the coupon would not have been obvious. The Examiner notes that as the Appellant has cited, ARC announced that as of June 7, 2000 agents "can now print agent coupons on non-accountable stock or *capture the coupon data*" on an optical media (emphasis added). The Appellant is attempting to interpret capturing the coupon data as being limited to capturing the image of the agent coupon itself (although no paper copy of

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such a coupon was required to be generated). The Examiner assumes that since the coupon data is being stored on "optical" media, the Appellant believes that only image files may be stored thereon. However, optical media refers to the method by which the data is placed on and retrieved from the storage medium (using optical light, such as a laser instead of electro-magnetic waves, to store data on a storage medium), not the type of files stored thereon. Since the ARC explicitly indicated that the agent coupon data may be captured onto an optical media, such as a CD-ROM or DVD, the Examiner maintains his 35 U.S.C. 102(f) rejection that the Appellant is not the inventor of the agent coupon storage system, but merely an implementer of the ARC's directives.

Furthermore, even without such a disclosure by the ARC, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the agent coupon data, or any other data for that matter, may be stored on a CD-ROM or DVD as an image file, a text file, or as plain data as long as the data could be reconstituted into the proper format to reproduce the agent coupon. There are a wide variety of compression means used to store images, graphics, and textual documents in databases, and all of these means also include means for decompress the database file into the original image, graphic, or textual document. Additionally, when an image of a document (or picture) is placed onto microfiche it is stored as an actual image which may be viewed by a person holding the microfiche up to a light source and using a magnifying glass to see the actual image. In other words, the image is not broken down or converted in format, it is just reduced in size. However, when storing an image or picture onto electronic memory mediums, such as a hard drive, CD-ROM, or DVD, the

image/picture is parsed into its constituent parts and stored as data on the storage medium. When the image/picture is requested, the data is retrieved from the storage medium, reconstituted into the proper format, and output to the display or printer. Thus, while it may appear to the user that the actual document image or picture is being stored on the medium, in reality, what is being stored is data which can be used by the proper reader to reformat the data into an exact likeness of the original image. The Examiner is not familiar with any known method of actually storing images or pictures onto such optical mediums.

Finally, whether the ARC had authorized storage of the agent coupon as a data file instead of an image file (i.e. the legality of it) has no bearing on whether or not it would have been obvious to store the data in a particular format, especially when all of these formats were well known and used throughout the computer industry for the past several decades. For example, although it is unlawful for a 16 year-old to drink alcohol in most States, it is obvious that one may do so. If a State lowered its drinking age to 16, it would not be a novel idea to sell alcohol products to the 16 year-old using the same methods previous used to sell alcohol to "adults". Thus, storing a document as data instead of an image is not novel just because a regulatory agency has placed limitations on the storage means for certain documents. When the regulation changes, so does the available storage means and mediums. In the present instance, the ARC indicated that its ultimate goal was "to have a master storage database for these documents" (agent coupons)(Memorandum of September 30, 1999); and that "the IAR database would be the preferred method of storage, however, the proposal for optical

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storage means would provide a possible short-term solution" (JAB-ARA Meeting Minutes of October 27, 1999). And, finally, the ARC asked "if any vendors have the capability to optically store agent coupon information or would be interested in developing such an application" (ARC meeting of September 15, 2000). Thus, the ARC repeatedly indicated that the agent coupons (or agent coupon information) would be stored in an electronic database, and the Appellant has merely developed the requested application (computer program) which implements the features outlined by the ARC.

In reference to the Appellant's argument that "a rejection under 35 U.S.C. 102 requires that each element or limitation of a claim must be found in a single source" and that "the Examiner did not rely on one single source", but "relied on a number of the separate documents by ARC and the Travel Weekly News" (page 10); the Examiner notes that the rejection is based on the policy and procedures developed by ARC. The examination pertaining to the electronic storage of agent coupons. All of the documents used in this rejection clarify the ARC's policy and procedures and show that the claimed concept corresponds thereto.

b. The Examiner Erroneously Reject Claims 1-15, and 17, 18 Under 35 U.S.C. 103.

The Appellant begins by reiterating the argument pertaining to whether the ARC discloses storing images or data. This argument has been addressed above.

The Appellant continues by stating that he "considered ARC to be one of ordinary skill" (page 17). The Examiner notes that while ARC may have some employees (e.g. computer programmers) who would be considered of ordinary skill in the art when

programming a computer system to store the agent coupons, not everyone employed by that organization would have the same level of skill. The Applicant proves this by citing a letter from Nancy Johnson from ARC on January 19, 2001 that she was surprised that the Appellant could print agent coupons on demand and that it was a facsimile of the agent coupon (page 21). Anyone having even basic skill in the art of computer programming would have known how to store a document and then retrieve and display/print a document which was a perfect facsimile of the original document. The most common method of doing so is through the use of "forms" or "templates" which provide the basic formatting instructions and non-variable data for the document. The variable data is then inserted into the form/template to produce a unique document. Each document created thusly would be an exact image of other documents created in this way with the exception that the variable data would differ, e.g. the name and address blocks would contain information pertaining to different passengers. The form could contain

The Appellant argues that the Friedes reference is non-analogous art and therefore, there is no motivation to combine the Friedes reference with the ARC articles (page 17). In particular, the Appellant points out that Friedes does not disclose that the airline ticket information includes an agent coupon and that printing out the agent coupon "would defeat the entire thrust of his paperless invention" (page 21). The Examiner notes that the ARC articles, and the Appellant himself, make it abundantly clear that an agent coupon must be generated for each and every ticket transaction. Thus, it is inherent that when Friedes generates and stores the electronic ticket information it must also generate and store the agent coupon as per the ARC

regulations. Friedes shows that this information can be stored on optical memory media such as a Smart card (CD-ROM or DVD). Thus, both references pertain to storing travel information electronically. As per the printing of the coupon defeating the entire thrust of his invention, it is obvious that if the data is stored within the computer system's memory, it can be printed or displayed or transmitted to other nodes on the system. In the case of Friedes, it may be desirable to product a printed copy of the stored documents during such things as audits, tax filings, legal proceedings, etc. such as discussed by the ARC articles when they indicate that a printed facsimile of the agent coupon must be made available during audits.

The Appellant also argues that the ARC Handbook teaches away from the claimed invention and cited a couple phrases therein which talk about printing the same information that would be on an agent coupon, not just selecting data elements; and capturing the image of the coupon, not creating a database (page 22). However, the ARC articles disclose creating just such a database and capturing the agent coupon data on an optical media. The Examiner believes that the Appellant has misinterpreted the cited phrase "you need to print the same information that would be on the agent's coupon". This does not mean that a copy of a previous agent coupon is made, such as what happens when a microfiche viewer prints a copy of a document stored on the microfiche. Instead, it should be interpreted as printing an agent coupon which contains the exact same information (data) that would have been on the agent coupon if it had been printed at the time of the reservation transaction (as was currently done in the paper-based system). As per the citation about capturing an image of the agent coupon

and not creating a database, the Examiner notes that a memory media that stores a plurality of similar files (including a microfiche) is a database. Even if one could somehow capture an image (i.e. picture) of a document and store it on an optical media without breaking it into bits of data, one would be creating a database of such pictures as soon as more than one picture was stored thereon. The ARC refers to this when indicating that all of the stored agent coupons needed to be immediately accessible for their auditors, i.e. the database needs to be indexed. The Examiner interprets the citation to mean that all of the data making up an agent coupon is stored on the optical media, not just some of the "variable" data as discussed above. If all of the data is stored on the media, it would be trivial to retrieve and recompile the data into an exact duplicate of the document. Thus, the ARC is not teaching away from storing the agent coupon in a database, but is disclosing that the agent coupons need to be stored in an indexed database.

c. The Rejection of Claims 2-4 Under 35 U.S.C. 103.

The Appellant argues that ARC does not mention that the coupon image can be stored on a hard drive (page 23). However, as in the rejection above, the Examiner notes that ARC discusses the pros and cons of different types of storage media which could be used to store the agent coupons. While they decided that certain types of media are not secure enough for their purposes due to the fact that they could be written over (e.g. the data could be erased or changed), their disclosure that it is possible to store the data on these types of media renders it obvious that if the above security issue was not of concern, the agent coupons could be stored on other types of

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media to include hard drives. Their disclosure does not teach away from using other types of memory media, but merely selects one or more which are more desirable for their purpose and rules.

As to the Appellant's argument that the rejection of Claims 2-4 relies solely on the IAH and not on Friedes, thus "there is no issue as to combining the references under section 103" (page 23), the Examiner notes that these are dependent claims which rely upon the parent claim which was rejected under section 103. Therefore, it is not only proper, but required, that these claims also be rejected under the same section.

d. The Rejections of Claims 6-9 Under 35 U.S.C. 103, and The Rejection of Claims 10-14 Under 35 U.S.C. 103.

The Appellant presents the same arguments for both sets of claims. To facilitate expeditious evaluation of these arguments by the Board the Examiner will respond only once for each argument. However, the arguments should be considered to pertain equally to both sets of claims. The Appellant begins by arguing that "Since the Examiner state a motivation for his combination of the references, he implicitly admits that the combination is made in hindsight" (pages 24 and 25). The Appellant then continues that "By not incorporating the Examiner's stated motivation of claims 1, 5, and 15-18, he is estopped from rejecting claims 6-9 under section 103" (page 24) and "claims 10-14 under section 103" (page 25). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account

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only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present instance, the Friedes invention must, by law, follow the guidelines put forth by the ARC. Furthermore, both references were directed toward the same goal of issuing and storing electronic (paperless) airline tickets and corresponding documentation. Thus, the combination of the two references is not hindsight, but is mandated by the rules and regulations put forth by the ARC.

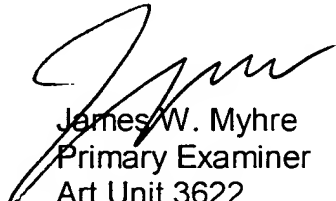
The Examiner is unsure of the point of the Appellant's second argument pertaining to the estoppel of a section 103 rejection of dependent claims because the motivation to combined the references cited in the parent claims was not repeated in the dependent claims. An argument rejecting dependent claims automatically incorporates the arguments of the parent claims, plus additional arguments pertaining to the features/limitations found in the dependent claims. This is much like the required format for the Appellant's submission of dependent claims in which the dependent claim automatically incorporates the features/limitations of the parent claim without actually repeating all of these features/limitations in the dependent claim. By indicating in the rejection of each of these groups of claims that the references "disclose a method for printing an airline ticket **as in Claim 1 above**" (emphasis added), the Examiner has explicitly incorporated the arguments, rejections, and motivations of the parent claim into the dependent claims.

The Appellant concludes his arguments by indicating that since these two groups of claims depend upon allowable claims, they are also patentable. While this may be true, the Examiner has shown above that the parent claims are not patentable, rendering this argument mute.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JWM 
February 20, 2004


James W. Myhre
Primary Examiner
Art Unit 3622

Conferees:

Eric Stamber 

Melanie Kemper 

Richard M. Saccocio, P.A.
100 Southeast 12th Street
Ft. Lauderdale, FL 33316